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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,950	06/14/2005	Max Aebi	001227.0209	7507
69095 7590 04/16/2008 STROOCK & STROOCK & LAVAN, LLP 180 MAIDEN LANE NEW YORK, NY 10038				
EXAMINER				
SCHILLINGER, ANN M				
ART UNIT		PAPER NUMBER		
3774				
MAIL DATE		DELIVERY MODE		
04/16/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/538,950

**Applicant(s)**

AEBI ET AL

**Examiner**

ANN SCHILLINGER

**Art Unit**

3774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 7-20 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date 7/5/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-3 and 7-18, drawn to an intervertebral implant.

Group II, claim(s) 19 and 20, drawn to a method of replacing an intervertebral disc.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the intervertebral implant lacks the same special technical features of the method of replacing an intervertebral disc, where the method call for blocking means to be inserted into the joints of the areas where repair is needed.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

During a telephone conversation with Giuseppe Molaro on 4/4/2008 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-3, and 7-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims

19 and 20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 and 7-18 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Claim 1, recites the limitations "the upper joint section," "the lower joint section," and "the central joint section." There is insufficient antecedent basis for these limitations in the claim. It is unclear if the claim language is intended directed towards these joint sections is intended to refer to general areas of the joint elements or areas within the upper and lower sections described in claim 1.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Beaurain et al. (US Pub. No. 2004/0243240). As shown in Figures 6a, 9a, and 9b, Beaurain et al. discloses an intervertebral implant with an upper section (3) and lower section (1) with a ventral side area, dorsal side area, lateral side areas, top apposition surface, and a bottom surface (Figure 5); the sections are movable (paragraph 0045); two joints (2, 4, 5), with an upper joint element having a concave sliding surface (32), a central joint element with a complementary sliding surface (23), a lower convex sliding surface (5) complementary to a concave sliding surface (21) on the central joint element. The sliding surfaces have circular cylindrical surface areas (See Figure 5). Beaurain et al. further discloses different means (113, 331; or 161; or 163) for keeping the upper and the lower sections at a fixed distance from each other. Elements 113 and 331 can be attached to the two ventral side areas of the upper and the lower sections. Elements 161 and 163 consist of inserts within depressions. Please note that the axes claimed may be arbitrarily placed as needed to meet the claims' limitations.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beaurain et al. Beaurain et al. discloses the invention substantially as claimed except for a concave surface on the lower joint element and a convex surface on the upper joint element. Rather,

Beaurain et al. discloses the reversed situation as described above, however the Beaurain et al. reference may be inverted to meet the claims' limitations. In addition, it would have been obvious to one having ordinary skill in the art at the time the invention was made invert the convex and concave surfaces as it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beaurain et al. in view of Rogers et al. (US Pub. No. 2004/0002761). Beaurain et al. discloses the invention substantially as claimed, however, Beaurain et al. does not disclose using dovetail guides as part of the means to keep the upper and the lower sections at a fixed distance. Rogers et al. teaches an intervertebral disc that uses dovetail depressions as part of the means to keep the upper and the lower sections at a fixed distance in paragraphs 0115-0120 for the purpose of preventing the parts of the prosthesis from moving to far in a posterior direction. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use dovetail depressions as part of the means to keep parts of the prosthesis at a fixed distance in order to prevent the parts of the prosthesis from moving to far in a posterior direction.

Claims 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beaurain et al. in view of Michelson (US Pub. No. 2002/0128712). Beaurain et al. discloses the invention substantially as claimed, however, Beaurain et al. does not disclose having drill holes running through the ventral side areas to the apposition surfaces. Michelson teaches a spinal implant with drill holes running through the ventral side areas to the apposition surfaces in paragraphs 0035-0050 for the purpose of housing bone screws that will secure the prosthesis in its desired location. Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to place drill holes in the prosthesis running through the ventral side areas to the apposition surfaces in order to housing bone screws that will secure the prosthesis in its desired location.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANN SCHILLINGER whose telephone number is (571)272-6652. The examiner can normally be reached on Mon. thru Fri. 9 a.m. to 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ann Schillinger/  
Examiner, Art Unit 3774

/Corrine M McDermott/  
Supervisory Patent Examiner, Art Unit 3738

